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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/206,720	12/07/98	WILSON	K 20WILSON/BOA

LYON & LYON  
JOHN M. BENASSI  
633 WEST FIFTH STREET  
SUITE 4700  
LOS ANGELES, CA 90071

PM11/0528

EXAMINER

VANAMAN, F

ART UNIT	PAPER NUMBER
3611	8

DATE MAILED: 05/28/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/206,720</b>	Applicant(s) <b>Wilson et al.</b>
	Examiner <b>Frank Vanaman</b>	Group Art Unit <b>3611</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-9 and 11-28 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-9 and 11-28 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Status of Application**

1. Applicant's Petition to Make Special (Infringement) is noted, the petition has been granted as set <sup>forth</sup> noted in paper No. 7, mailed to applicant on May 18, 1999. Claims 1-9 and 11-28 are pending, claim 10 having been canceled by the preliminary amendment.

**Specification**

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claims 6 and 19, the claims recite plastic end guards, however the specification, in the description of the preferred embodiment fails to disclose the material from which the end caps are made. Note page 7, lines 3-4. The specification should provide basis for the material of the end guards.

3. The disclosure is objected to because of the following informalities: on page 4, line 20, "inventors" should be --inventors'--.

Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 13, 14, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox (US 2,926,364). Cox teaches an aluminum (col. 2, lines 25-29) sports board having an arcuate upturned front end (13), a rear end with arcuate sections (plugs 28), top and bottom surfaces, a plurality of longitudinal hollow sections (14) extending the length of the board, including a central keel portion formed as part of the bottom surface (22, fig. 4, for example)

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having a width and height wherein the width is equal to the height (being a circular cross section), and hollow side rails (proximate numerals 10, 11, again in fig. 4) extending the length of the board.

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 5, 8, 12, 17, 21, 23-25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox. The reference to Cox teaches an aluminum (col. 2, lines 25-29) sports board having an arcuate-shaped upturned front end (13), a rear end with arcuate sections (shaped plugs 28), top and bottom surfaces, a plurality of longitudinal hollow sections (14) extending the length of the board, including a central keel portion formed as part of the bottom surface (22, fig. 4, for example) having a width and height wherein the width is equal to the height (being a circular cross section), and hollow side rails (proximate numerals 10, 11, again in fig. 4) extending the length of the board. The reference of Cox fails to teach particular length and width dimensions of the board. As it is generally well known to scale sports boards, for example, to suit an intended use such as size and age of a user and as Cox suggests the making of the parts in a range of "suitable sizes" (col. 3, lines 6-7), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the sports board of Cox having a width range between 5 and 12 inches and length range between 24 and 60 inches to accommodate a particular size of user.

As regards claims 8 and 21, the reference of Cox fails to teach the rear end as having a upwardly bent portion. In view of the forward end of the board of Cox having an upturned

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portion, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an upturned end to the rear of the sports board, for the purpose of allowing rearward motion of the board, during stunts, for example.

As regards claim 17, in view of Cox suggesting other materials than aluminum for manufacture (col. 2, lines 28-29, col. 3, lines 6-7), and as it is generally well known that titanium exhibits a relatively high strength per unit weight, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the sports board taught by Cox from titanium for the purpose of adjusting the strength-to-weight ratio of the board.

As regards claims 23 and 24, Cox fails to provide particular force to deflection characteristics for the sports board, however, due to the use of circular cross section materials such deflection characteristics may be easily achieved by selection of the tube thickness, and as such it would have been obvious to one of ordinary skill in the art at the time of the invention to select the material characteristics of the constituents of the board such that deflection is limited under particular loadings for the purpose of tuning the board by stiffening it.

As regards claims 25, 27 and 28, the reference of Cox fails to explicitly teach the method steps of forming the board, the board may be made by such a method. As regards claim 25, the reference of Cox fails to teach a heat treating of the board. Heat treating is very well known in the mechanical arts, for example as an annealing step, and is particularly well known where materials may be shaped (such as by bending) and resultantly work-hardened to the point that they become more brittle than the non-worked material. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to heat treat the board of Cox as part of its manufacture, for the purpose of preventing brittle failure in the board after bending processes.

8. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Joyce (US 3,374,495). The reference of Cox fails to teach plastic end guards on the end of the board. Joyce teaches a sports board (10) having a plastic bumper (11) affixable to the end

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of the board. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an end guard as taught by Joyce at a front end of the board of Cox for the purpose of protecting the front end of the board, as suggested by Joyce (col. 1, lines 19-30). The reference of Cox as modified by Joyce fails to explicitly teach an end guard at the rear end of the board. It would have been obvious to one of ordinary skill in the art at the time of the invention, however, to provide a second guard as taught by Joyce at the rear of the sports board of Cox for the purpose of protecting the rear end of the board as well, particularly in view of Joyce's teaching that the guard may be reshaped by the user to accommodate different profiles (col. 3, lines 1-7).

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox in view of Mayr (US 5,249,819). The reference of Cox, as modified with respect to claim 25, fails to teach the method step of providing an extruded board portion. Mayr teaches a sports board having a hollow section, wherein the board sections may optionally made by extrusion when the envisioned width of the board is to remain constant (col. 2, lines 16-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to make the board, with the exception of the end portion 18, from an extruding process as suggested by Mayr, for the purpose of allowing flexibility in the length; the manufacturer being able to simply choose a desired length and cut a section of a continuously extruded core to that desired length.

10. Claims 1-5, 8, 9, 11-18, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbals (US 4,234,204) in view of Vogel (US 3,762,734). Tibbals teaches a sports board (10) having top, bottom and side surfaces, with upturned front and rear ends (fig. 2), the ends having arcuate shaped portions, the board having a plurality of hollow sections extending between the front and rear ends of the board, including a central keel portion (between ridges 16) having a width greater than its height (see fig. 4) and a pair of laterally spaced side sections

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(between the board rim and respective ridges 16), the board underside carrying front and rear wheel trucks (6, 8). The reference of Tibbals fails to teach specific length and width dimensions. As it is generally well known to scale sports boards, for example, to suit an intended use such as size and age of a user, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the sports board of Tibbals having a width range between 5 and 12 inches and length range between 24 and 60 inches to accommodate a particular size of user. The reference of Tibbals fails to teach the board as being made from aluminum. Vogel teaches a sports board comprising structural shells (2, 3) made from a metal such as aluminum. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the board of Tibbals from a metal, such as aluminum, for the purpose of providing a generally lightweight, yet strong and durable board structure.

As regards claim 17, the reference of Tibbals as modified by Vogel fails to teach the board as being made of titanium. Titanium is generally well known for a relatively high strength per unit weight, and in view of this strength, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the sports board taught by Tibbals as modified by Vogel from titanium for the purpose of adjusting the strength-to-weight ratio of the board.

As regards claims 23 and 24, the reference of Tibbals as modified by Vogel fails to provide particular force to deflection characteristics for the sports board, however, it is generally well known to adjust cross sections of elements to obtain different stress-strain characteristics and as such it would have been obvious to one of ordinary skill in the art at the time of the invention to select the material characteristics, for example the thickness, of the board such that deflection is limited under particular loadings for the purpose of tuning the board by stiffening it.

11. Claims 6 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbals as modified by Vogel as applied to claims 5 and 11, respectively above, and further in view of Endo et al. (US 5,487,441). The reference of Tibbals as modified by Vogel fails to teach plastic end

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guards connected to the ends of the board. Endo et al. teach a sports board having a board structure with ends to which are attached resilient guards (2, 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide resilient guards as taught by Endo et al. to the front and rear ends of the sports board of Tibbals as modified by Vogel for the purpose of protecting the board from abrasion during usage.

12. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tibbals as modified by Vogel as applied to claims 1 and 11, respectively above, and further in view of Zatlin (US 4,887,824). The reference of Tibbals as modified by Vogel fails to teach the top surface of the board as having a transversely concave profile. Zatlin teaches a sports board having a top surface (fig. 2) having a transversely concave profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the top surface of the board of Tibbals as modified by Vogel in a concave shape as taught by Zatlin for the purpose of providing a profile which tends to center a user's feet on the board.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hunt (US 1,552,990), Salvo (US 3,360,277), Dickert (US 3,722,900), Eash, II (US 4,076,265), Mayr et al. (US 5,299,822), Henrich (IT 494087), Rellstab (CH 169,739), and Baudou (FR 84,816) teach sports board structures and attachments of pertinence.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents  
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry;  
informal or draft communications may be faxed to the same number but should be  
clearly labeled "UNOFFICIAL" or "DRAFT")

**FRANK B. VANAMAN**  
Patent Examiner  
Art Unit 3611

May 25, 1999

  
5/25/99